1651

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TRANSMITTAL FORM

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Application Number	09/993,348
Filing Date	November 10, 2001
First Named Inventor	Parwinder Grewal
Art Unit	1651
Examiner Name	Deborah Ware
Attorney Docket Number	22727/04028

Total Number of Pages in This Submission: 1

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☑ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
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- ☐ Status Letter
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Firm or Individual name	Sean C. Myers-Payne Reg. No. 42,920
Signature	Sean Myers-Payne
Date	May 3, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
GREWAL, Parwinder	)	Group Art Unit: 1651
	)	
Application No.: 09/993,348	)	Examiner: WARE, Deborah
	)	
Filed: November 10, 2001	)	Attorney Docket No.: 22727/04028
	)	
For: Direct Application of Desiccated Entomopathogenic Nematodes for Biological Pest Control	)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

This paper is responsive to the Office Action mailed April 6, 2004, which set a one-month shortened statutory period for response. This Response is timely filed on or before May 6, 2004, and no fee is required for its consideration.

Restriction Requirement

In the Action mailed April 6, 2004, the Office restricted the application to the following Groups of claims:

I: claims 1-13, 15-17, and 31, drawn to a method of protecting plants;

II: claims 18-21, drawn to a formulation composition; and

III: claims 22-30, drawn to a method for preserving nematodes.

Election

Applicant elects Group I, i.e., claims 1-13, 15-17, and 31, *with traverse.*

The Office carefully makes the case that the claims of Groups I, II, and III, are *distinct*:

> Inventions I and II are related as product and process of use. The inventions can be shown to be *distinct* if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the product as claimed can be used for suspending nematodes. Further, the methods of Group I and Group III are related as processes but are two different processes and require different process steps. Also the Groups II and III are related as product and process of use, however, the product can be used to protect plants. Thus, one way *distinctness* is established between the processes and product. Further, the methods of Group I and III are *distinct* and different as discussed above. Therefore, two way *distinctness* exists between the two different and distinct methods.

(Office Action, page 2, lines 10-21, emphasis added.) Without more, the Office concludes by stating that because distinctiveness has been shown, restriction is proper. (*Id.* at page 3, first and second paragraphs.)

Applicant submits that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction.

> There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; **and (B) There must be a serious burden on the examiner if restriction is required**.

(M.P.E.P. § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: distinctness *and* a serious burden. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I, II, and III may satisfy the Office's requirements for distinctness, their consideration would hardly result in a serious burden on the Office. In fact, the Office had already considered *and searched* claims 1-21 prior to Applicant's previous amendment. Thus, at the very least, the Office should consider Groups I and II (i.e., claims 1-21 and 31) together.

If issues relating to this application can be resolved by discussion, the Examiner is invited to contact the undersigned attorney by telephone. If any fees are due for consideration of this Response, the undersigned hereby authorizes the Office to charge those fees to Applicant's deposit account no. 03-0172.

Respectfully submitted,

Date: May 3, 2004

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